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REMARKS

Interview request

Applicants also respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendment. Applicants request the Examiner call Applicants' representative at 858 720 5133.

Status of the Claims

Pending claims

Claims 1 to 50 are pending.

Claims canceled and added in the instant amendment

Claims 4, 5, 7 to 10, 18 and 19, and 23 to 49, are canceled, without prejudice or disclaimer and claims 51 to 62 are added. Thus, after entry of the instant amendment, claims 1 to 3, 6, 11 to 17, 20 to 22 and 50 to 62 will be pending and under consideration.

Support for the Claim Amendments

The specification sets forth an extensive description of the invention in the new and amended claims. For example, support for claims directed to methods of expressing phytases comprising a homologous signal sequence or comprising a heterologous signal sequence in place of the homologous signal sequence, and in one aspect, comprising a sequence imparting a desired characteristic, can be found, inter alia, in paragraphs [0254], [0315] and [0316] of U.S. Patent Application Publication No. 20040091968 ("the '968 publication"). Support for claims directed to methods of expressing phytases, wherein the phytase-encoding nucleic acids are within various expression and/or cloning systems, can be found, inter alia, in paragraphs [0283] and [0284] of the '968 publication. Support for claims directed to methods of expressing phytases in various yeast cells can be found, inter alia, in paragraph [0039] of the '968 publication.

Group Restriction Requirement

The Patent Office alleged that the pending claims of the application are directed to six separate and distinct inventions under 35 U.S.C. §121, as set forth in detail pages 2 to 5 of the OA:

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Group I: drawn in part to a phytase comprising SEQ ID NO:2, and classified in, inter alia, class 435, subclass 196.

Group II: drawn in part to a phytase comprising SEQ ID NO:10, and classified in, inter alia, class 435, subclass 196.

Group III: drawn in part to a method of recombinantly producing the polypeptide of SEQ ID NO:2, and classified in, inter alia, class 435, subclass 69.1.

Group IV: drawn in part to a method of recombinantly producing the polypeptide of SEQ ID NO:10, and classified in, inter alia, class 435, subclass 69.1.

Group V: drawn in part to a method for treating a feed with the phytase polypeptide of SEQ ID NO:2, and classified in, inter alia, class 435, subclass 19.

Group VI: drawn in part to a method for treating a feed with the phytase polypeptide of SEQ ID NO:10, and classified in, inter alia, class 435, subclass 19.

The Group Election, with traverse

In response to the Group Restriction Requirement, Applicants elect Group IV, including, inter alia, pending claims 1, 2, 20 to 22, 29, 50 (and new claims 51 to 58), drawn to, inter alia methods of recombinantly producing the polypeptide of SEQ ID NO:10, and classified in, inter alia, class 435, subclass 69.1, with traverse.

Reasons to reconsider and withdraw restriction requirement

Applicants respectfully request the Patent Office reconsider and, in part, withdraw the group restriction requirement for the following reasons:

All exemplary phytases should be rejoined to a generic Group IV

Applicants respectfully submit that all exemplary phytases sequences, including the phytase encoding nucleic acids SEQ ID NO:1 and SEQ ID NO:9, and the phytases SEQ ID NO:2 and SEQ ID NO:10, should be rejoined to a generic Group IV; in other words, Groups III and IV should be joined to a generic group drawn to methods for making a polypeptide having a phytase activity comprising, inter alia, expressing a phytase-encoding nucleic acid in a yeast.

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Group IV includes generic claims 1 and 2, both drawn to methods for making a polypeptide having a phytase activity:

Claim 1 (as amended): A method for making a polypeptide having a phytase activity comprising:
providing a nucleic acid derived from a bacteria encoding a polypeptide having a phytase activity; and
expressing the nucleic acid in a yeast under conditions which allow expression of the enzyme in the yeast.

Claim 2 (as amended): A method for making a polypeptide having a phytase activity comprising:
providing a non-natural or synthetically generated nucleic acid encoding a polypeptide having a phytase activity;
expressing the nucleic acid in a yeast under conditions which allow expression of the enzyme in the yeast.

If the instant group restriction requirement is allowed to stand, Applicants will not be allowed to claim their invention as they choose. If the elected invention is limited to only methods for making one of the exemplary phytases sequences (e.g., SEQ ID NO:2 or SEQ ID NO:10), the full scope of the genus claimed in claims 1 and 2 would never be examined. Even if Applicants filed divisional applications to all the groups (i.e., methods for making SEQ ID NO:2 and SEQ ID NO:10), the scope of the genus claimed in claims 1 and 2 will never be examined. In other words, if claims 1 and 2 are required to be divided up and presented in different applications, the full scope of pending claims 1 and 2 would never be considered on its merits. The totality of the resulting fragmentary claims would not be the equivalent of the original claim 1 and/or claim 2.

The procedure for handling applications that include generic claims is set forth in 37 CFR §1.146. This rule provides that "[i]n the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable."

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As stated in MPEP §809.02(a), “[u]pon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.” Thus, where generic claims are present, an applicant can be required to elect a species for initial examination, but the generic claims are still subject to examination to determine whether such generic claims are allowable (emphasis added). MPEP §809.02(a); pg 800-52 to 800-53, 8th Edition, rev. 3, August 2005.

In the instant restriction requirement, this required procedure is not being followed. Claims 1 and 2 are a proper generic claim within the requirements set forth in 37 CFR § 1.141. Claims 1 and 2 each satisfy the definition of a generic claim as set forth in MPEP §806.04(d), in that each includes limitations that are not present in all claims that depend from it. Therefore, an election of species requirement is permissible, but a restriction requirement is not. (MPEP §806.04(d), pg 800-42 to 800-43, 8th Edition, rev. 3, August 2005).

Moreover, because this restriction requirement splits claims 1 and 2 into multiple groups (a method for making each exemplary phytase, according to the Office, is allegedly patentably distinct), the restriction requirement is improper as a matter of law. The courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. 121, provides no legal authority for not examining a broad generic claim. See, In re Weber, 198 USPQ 328, 331 (CCPA 1978); In re Haas, 179 USPQ 623, 624-625 (*In re Haas I*) (CCPA 1973) and In re Haas 198 USPQ 334-337 (*In re Haas II*) (CCPA 1978). As stated in In re Weber:

“The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim—no matter how broad, which means no matter how many independently patentable inventions may fall within it.” 198 USPQ 328 at 334.

In a case such as the instant case, where a claim is generic, a restriction requirement is tantamount to a rejection of the claim. The CCPA made this point very clear in In re Haas I:

“We find that the action taken by the examiner did in fact amount to a rejection. . . . Those claims were withdrawn from consideration not only in this application but prospectively in any subsequent application

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because of their content. In effect there had been a denial of patentability of the claims. Presumably only by dividing the subject matter into separate, and thus different, claims in plural applications could an examination of the patentability of their subject matter be obtained." 179 USPQ at 625.

If the instant restriction requirement is allowed to stand, Applicants will not be accorded "the basic right of the applicant to claim his invention as he chooses." In re Weber, 198 USPQ at 331. In In re Weber, the CCPA stated that "[a]s a general proposition, an applicant has a right to have *each* claim examined on the merits" (198 USPQ at 331, emphasis in original). The Court went on to state that:

"If . . . a single claim is required to be divided up and presented in different applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification." 198 USPQ at 331.

Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. MPEP §803.02, pg 800-4 to 800-5, 8th Edition, rev. 3, August 2005. Even if Applicants were to file multiple divisional applications in addition to the instant application to obtain coverage for each of the alleged groups, Applicants would not have the opportunity to have their broader generic claim examined, i.e., Applicants would not have the opportunity to have that which they regard as their invention examined. The claims of the divisional applications would be limited to the particular exemplary phytase sequences. One seeking to avoid infringement could simply choose an alternative phytase that is not specifically claimed in any particular (divisional) application. In effect, the restriction requirement is reading into Applicants' independent claims limitations that are not present in the claims as filed. Claims 1 and 2 as filed and pending, for example, would never be considered, and thus never allowed, under the current restriction

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requirement. Only the dependent claims which are set forth in the respective restriction groups would be examined.

Applicants therefore respectfully request that the instant restriction requirement with respect to all the groups be withdrawn (and rejoined as a generic restriction Group IV) and treated as though it were a species election under the procedure set forth in MPEP 809.02(a).

Pursuant to 37 C.F.R. § 1.144, Applicants reserve the right to petition for review of the restriction requirement at any time prior to appeal. Applicants also submit that because the instant restriction requirement is tantamount to a rejection of the generic claim 1, the restriction requirement is appealable to the Board of Patent Appeals and Interferences. In re Haas I. If the instant restriction requirement is allowed to stand, Applicants will not be accorded "the basic right of the applicant to claim his invention as he chooses." In re Weber. It is improper for the Office to refuse to examine that which Applicants regard as their invention. MPEP §803.02, pg 800-4 to 800-5, 8th Edition, rev. 3, August 2005.

Accordingly, Applicants respectfully request reconsideration of the restriction requirement and request that the restriction requirement with respect to Groups III and IV be withdrawn and treated as a species election under the procedure set forth in MPEP 809.02(a); in other words, Applicants request that the restriction requirement with respect to all the SEQ ID NO:s (the nucleic acid and polypeptide sequences, e.g., SEQ ID NO:2 or SEQ ID NO:10) be withdrawn and treated as a species election under the procedure set forth in MPEP 809.02(a).

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CONCLUSION

Applicants have elected the invention of Group IV, with traverse, for reasons stated above, and respectfully request that the claims of Group IV and Group III be rejoined to a generic group drawn to methods for making a polypeptide having a phytase activity comprising, inter alia, expressing a phytase-encoding nucleic acid in a yeast.

Thus, in this response Applicants traversed the group restriction requirement and respectfully requested the restriction be withdrawn, in part, as discussed above. Applicants set forth distinct and specific errors in the restriction requirement and reasons for the Patent Office to reconsider and withdraw, in part, the restriction requirement. Applicants have also requested that the restriction requirement with respect to all the SEQ ID NO:s (the nucleic acid and polypeptide sequences) be withdrawn and treated as a species election under the procedure set forth in MPEP 809.02(a). Accordingly, Applicants have preserved their right to petition the restriction to the Group Director under 37 CFR §1.144; see also MPEP §818.03(c); pg 800-60, 8th Edition, rev. 3, Aug. 2005. Applicants will defer submission of the petition (which can be deferred until allowance of the claims).

It is believed that the all claims pending in this application after entry of the instant amendment are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket No. 564462001824. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at 858.720.5133.

Dated: May 1, 2006

Respectfully submitted,

By 

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